

REMARKS

Claims 1, 3, 4, 6-12 and 14-35 remain pending in this application. Claims 1, 3, 4, 6-12 and 14-35 are rejected. Claims 2 and 5 are previously cancelled. Claim 11 is amended herein to address matters of form unrelated to substantive patentability issues.

Applicants herein traverse and respectfully request reconsideration of the rejection of the claims and objection cited in the above-referenced Office Action.

Claim 11 is rejected as indefinite under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter of the invention as a result of an informality stated in the Office Action. The claim is amended to remove or correct the informality noted in the Office Action. Therefore, reconsideration of the rejection of the claim and its allowance are earnestly requested.

Claims 1, 3, 4, 6-12, 14-20, 23-25, 28-30 and 33-35 are rejected as obvious over Sato (US 4,858,930) in view of Yokoi (US 6,227,966) and Hawkins et al. (US 6,009,458) under 35 U.S.C. §103(a). The applicants herein respectfully traverse this rejection. For a rejection under 35 U.S.C. §103(a) to be sustained, the differences between the features of the combined references and the present invention must be obvious to one skilled in the art.

A brief summary of the claimed invention would appear to be in order before addressing the applied references of record. In accordance with the invention of each of independent claims 1, 4 and 7, directed respectively to a game apparatus, method

and storage medium, a character to be trained and training initial values thereof are set when a training mode is instructed in a first game machine, each of the training initial values reflecting at least one aspect of basic abilities of the character. Training values are then added to the training initial values of the character obtained in accordance with actions taken by the character in line with a training purpose. Different kinds of items having influence on the character when the item belongs to the character are given to the character. When it is judged that the training has been successful, character data of the character are transferred to a second video game apparatus when a transfer mode is instructed. The character data to be transferred include the training initial values of the character and the items given during the training, such that a user on the second video game apparatus can begin training of the character with said training initial values and said items. In this regard, it should be noted that the training values are initialized upon the transmission of the character to restart the training of the character in the second game machine from its initial training value. Also of note is that the items given to the character while being trained in the first game device are transmitted along with the character to the second game machine to exert influence on the character when trained in the second game device.

In view of the above objectives and directives, it is respectfully submitted that the Examiner is combining the cited references in such a way as to disregard portions thereof in their respective disclosures which teach away from making the

combination in the manner as suggested, and as addressed in detail in the discussion which follows.

The primary Sato reference is directed to relatively early video game devices (the application being filed back in 1988). At that time (almost two decades ago), a home video game lacked the sophistication and could not provide the multimedia experience that could be provided by a much more expensive commercial video game found, for example, in an arcade and the like. Therefore, it was the object of Sato to provide compatibility, regarding the game character, between a commercial video game apparatus and the home video game, such that the user could build up ability of the character at home, where he/she would not have to spend a great deal of money, as in an arcade, and then, when the character was developed to the point where it would be worthwhile for the user to bring the character to the commercial game machine (because the greater ability of the character would justify to the user the expense of play on the more sophisticated and costly machine justified since it would then be much more entertaining than experiencing play by an untrained character), the user could transfer the trained character to the commercial machine with the already trained values of the character.

The Office Action admits that Sato “lacks in specifically disclosing that character data of the character to be transmitted includes the training initial values of the character such that a user of the second game device can begin training of the character with said training initial values and said items.” (See paragraph bridging

pages 4 and 5 of the Office Action). This is no surprise, given that such a feature would defeat the very object of Sato, i.e., to allow transfer an already trained and advanced character to a more advanced game machine, as discussed above. It would be in direct conflict with the teachings of Sato to reset (i.e. initialize) the character values before the transfer, since it is the express goal of the Sato disclosure to delay transfer until a character developed sufficient skills to merit such transfer. Therefore, the Examiners statement that it would be obvious to combine the reference teachings with Yokoi , which allegedly teaches resetting of a virtual character (virtual pet) to an initial setting, would be contrary to the intent of Sato, and therefore is unfounded and incorrect. It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 230 USPQ 416, 420 (Fed. Cir. 1986) citing *In re Wesslau*, 353 F2d 238, 241, 147 USPQ 391, 393 (CCPA 1965). Not only would such combination not be obvious, it would be clearly unwarranted by the underlying principles of Sato, as described above.

The Yokoi reference mentioned above is directed to a virtual character akin to a virtual pet. The invention intends to have the user perform a corresponding action to a request made by the virtual creature, such as a request for food, restroom, play, sleep, etc. Thus, the basic premise of the game is communication between a

virtual creature and a player, and follows a chronological change in the character throughout its life-cycle. For example, in this regard, Fig. 14 of Yokoi shows a development stage of the virtual pet (i.e., character) from a baby state (KT1) through an old age state (KT11).

The interactions between the virtual pet and the user do not go beyond a level which sustains the virtual life, welfare or happiness of the virtual “pet” character. Caring for the virtual pet of Yokoi does not require operations rendering complex movements or actions of the virtual pet. Thus, there can clearly be no need or useful purpose for creating any item to be possessed by the virtual creature which might expand the complexity or variation of the actions made by the virtual pet of Yokoi, beyond the simple expressed intention of the disclosure to giving the creature life sustaining care, such as food, sleep, play, medical care, and the like. Consequently, there can be no conceivable purpose of combining the teachings of Hawkins, offered for alleged disclosure directed to a game item which may be extracted from one game machine and used in another game device, with the teachings of Yokoi, and the Examiner has offered no rational reason for doing so. Consideration must properly be given to teachings of the prior art which would lead one away from the claimed invention as well as those that might suggest the invention. *Mendenhall v. Astec Industries, Inc.*, 13 USPQ2d 1913, 1939 (Tenn 1988), *aff’d*, 13 USPQ2d 1956 (Fed. Cir. 1989). It is applicants’ position that the teachings of Yokoi are wholly incompatible with those of Hawkins, as Yokoi teaches away from the proffered

combination, by failing to disclose any reason for having game items, as proposed by Hawkins, possessed by the virtual pet disclosed in Yokoi.

Thus, it is respectfully submitted that the rejected claims are not obvious in view of the cited references for the reasons stated above. Reconsideration of the rejections of claims 1, 3, 4, 6-12, 14-20, 23-25, 28-30 and 33-35 and their allowance are respectfully requested.

Claims 21, 22, 26, 27, 31 and 32 are rejected as obvious over Sato (US 4,858,930) in view of Yokoi (US 6,227,966) and Hawkins et al. (US 6,009,458), in further view of official notice under 35 U.S.C. §103(a). The applicants herein respectfully traverse this rejection.

It is respectfully submitted that the subject matter for which the Examiner takes official notice adds nothing to supplement the argued deficiencies with regard to the above discussed combination. Thus, it is respectfully submitted that the rejected claims are not obvious in view of the cited references for the reasons stated above. Reconsideration of the rejections of claims 21, 22, 26, 27, 31 and 32 and their allowance are respectfully requested.

Applicants respectfully request a one (1) month extension of time for responding to the Office Action. Please charge the fee of \$120 for the extension of time to Deposit Account No. 10-1250.

The USPTO is hereby authorized to charge any fee(s) or fee(s) deficiency or credit any excess payment to Deposit Account No. 10-1250.

In light of the foregoing, the application is now believed to be in proper form
for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,
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